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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,489	11/21/2003	Robert Lewis Bixler JR.	DC - 4908CIP	2528

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/719,489

**Applicant(s)**

BIXLER ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 19 is/are pending in the application.
- 4a) Of the above claim(s) 17 to 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 to 16, drawn to a process, classified in class 523, subclass 211.
  - II. Claims 17 to 19, drawn to an apparatus, classified in class 366, subclass 69+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a process of compounding in which a filler other than a reinforcing silica filler is used, or a process of compounding using a polyester rather than a siloxane.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Robert McKellar on July 19, 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 1 to 16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 to 19 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 to 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilgrien et al. in view of Boudreau et al.

Bilgrien et al. teach a storage stable silicone composition that comprises blending a high consistency silicone with a silica filler and a treating agent for the filler at a temperature of from 100 to 200 °C. Particular attention is drawn to Example 1. This shows a blending step in which a high consistency silicone is mixed with silica and silica treating agents in a fluidized state at a temperature of 140 to 145 °C. The top of col. 9 teaches that the particle size of the composition at this point is between 10 and 700 microns. This meets instant step A) as claimed. This composition is then cooled by circulating cooling water throughout the jacket. The composition is fused using a two roll rubber mill which meets the massing step C). To this is added a peroxide catalyst and the resulting composition is recovered. This meets steps D). As such, the only claimed step not met by this specific example is step B), transferring the powder to a cooling device rather than cooling in the mixer used for step A.

The difference between the instantly claimed process and that in the prior art amounts to the difference between a batch process (Bilgrien et al.) and a continuous process. That is, for each compounding process in Bilgrien et al., the mixing process must end for the cooling process to begin, while in the claims the mixing process can continue because the cooling process is carried on in a different apparatus.

Boudreau et al. teach a continuous process for compounding siloxane and fillers. As can be seen, the mixing of the silica and siloxane are carried out in one mixer, while subsequent cooling is carried out separately. The filler/silicone polymer mixture is transferred to a different apparatus for cooling. See column 5, lines 5 to 10. This allows for a continuous process rather than a batch process.

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The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In the instant application, please note MPEP 2144.04 (V, E). It has been held that making a batch process continuous is obvious. The Examiner notes that comparable continuous processes are known in the art, as shown by Boudreau, and thus the skilled artisan would have known how to adapt the batch process in Bilgrien et al. such that it is a continuous process, i.e. by transferring the mixture to a cooling apparatus rather than halting the mixing (which requires heating) process to initiate cooling. Note for instance column 9, lines 23 to 30 of Bilgrien, which discloses that after the desired particle size has been obtained, the heating can either be discontinued and the product cooled or the hot material may be discharged. Discharging such a material directly into a cooling device would allow for a continuous process. In this manner claim 1 is rendered obvious.

The dependent claim limitations are also taught and/or suggested by Bilgrien et al. Note for instance the bottom of column 3 and column 4 which teach viscosities which meet and/or suggest claims 2 and 3. Note the amounts and type of filler taught on column 5 which meets claims 4 and 5. Column 5 through column 6 teaches the limitations of claims 6 and 7. The example cited supra meets claims 8 to 12. Platinum catalysts are taught on column 10, lines 30 and on. This meets claim 13. Column 9, line 59, teaches an extruder, meeting claim 15.

For claim 14, since the cooling means in Bilgrien et al. is carried out in a jacketed mixer, it would follow for the cooling step in the continuous process to occur in a jacketed mixer as well.

Finally, for claim 16, note that the mixing of silicone and filler provides uniformity, which in turn eliminates large bumps or agglomerates, and meets claim 16.

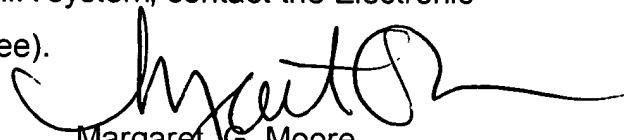
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

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272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
7/20/05